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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/005,064  | 12/04/2001  | Michael Campbell     | MBHB00-1257-B       | 9564             |
| 7590 02/13/2004   |             |                      | EXAMINER            |                  |
| A. Blair Hughes<br>McDonnell Boehnen Hulbert & Berghoff<br>32nd Floor<br>300 S. Wacker Drive<br>Chicago, IL 60606 |             |                      | RAO, DEEPAK R       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1624                |                  |
| DATE MAILED: 02/13/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/005,064 | <b>Applicant(s)</b><br>CAMPBELL ET AL. |  |
|                              | <b>Examiner</b><br>Deepak R Rao      | <b>Art Unit</b><br>1624                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-13,28-36,38-47 and 63 are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36,38 and 39 are rejected.
- 7) ☒ Claim(s) 1,3-13,28-35,40-47 and 63 are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1624

### DETAILED ACTION

Claims 1, 3-13, 28-36, 38-47 and 63 are pending in this application.

The rejections of the previous office action are rendered moot by the amendment filed on November 28, 2003.

The previous office action clearly indicated that the search was expanded to cover compounds wherein  $-N(AR^1)(R^2)$  is  $-NH_2$ ; Z is  $-NR^5-$ ;  $(Y^2)_p$  is lower alkylene; and  $m = 0$  (see page 2) and **not** compounds of formula (I) wherein Z is sulfur as interpreted by applicant. The following discussion of the elected species is provided to further clarify the searched and examined scope of the pending claims.

### *Election/Restrictions*

Applicant elected the species of Example 2 (see paper no. 4). The species represents a compound of Formula I wherein:

$X^1$ ,  $X^2$  and  $X^3$  are N;

A is a covalent bond;

$R^1$  and  $R^2$  are H;

Z is S;

$R^4$  is pentyl;

m is 0, n and p are 1;

$Y^2$  is methylene;

T is  $-O-$ ; and

Art Unit: 1624

R<sup>3</sup> is 4-*t*-butylphenyl.

The species reads on claims 1, 3-8, 10, 28-35, 36, 38-43, 45 and 63.

The elected species identically was not found in the prior art search and the search was expanded to the subgenus of Formula I wherein:

X<sup>1</sup>, X<sup>2</sup> and X<sup>3</sup> are N; ... (as defined for elected species)

A is a covalent bond; ... (as defined for elected species)

R<sup>1</sup> and R<sup>2</sup> are H; ... (as defined for elected species)

(i.e., N(R<sup>2</sup>)(AR<sup>1</sup>) together is NH<sub>2</sub>);

Z is S; ... (as defined for elected species)

R<sup>4</sup> is optionally substituted alkyl;

m is 0; ... (as defined for elected species)

n is 0 (i.e., T is absent);

p is 1; ... (as defined for elected species)

Y<sup>2</sup> is -CH<sub>2</sub>-; ... (as defined for elected species)

and R<sup>3</sup> is as defined in the claims,

and art was found. As per the guidelines of MPEP § 803.02, the Markush-type claims were examined the extent of the searched subgenus. The non elected species and the generic subject matter drawn to the non elected species from the pending claims is withdrawn from further consideration.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1624

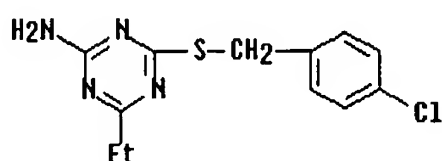
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Radics et al., CAPLUS abstract 107:198262 (1987). The instant claims read on reference disclosed compound, see RN 111039-46-4 (depicted below for convenience):

RN 111039-46-4 CAPLUS

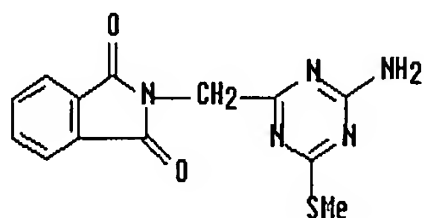
CN 1,3,5-Triazin-2-amine, 4-[[[4-chlorophenyl)methyl]thio]-6-ethyl- (9CI) (CA INDEX NAME)



2. Claims 36, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Maekawa et al., CAPLUS abstract 85:154963 (1976). The instant claims read on reference disclosed compound, see RN 35541-09-4 (depicted below for convenience):

RN 35541-09-4 CAPLUS

CN 1H-Isoindole-1,3(2H)-dione, 2-[[4-amino-6-(methylthio)-1,3,5-triazin-2-yl]methyl]- (9CI) (CA INDEX NAME)



*Note: As per the guidelines of MPEP § 803.02, the search and examination has been limited to the above described subgenus and is not extended to cover all the generic values of various variables in instant claims.*

### ***Allowable Subject Matter***

Claims 40-47 and 63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

Art Unit: 1624

claim and any intervening claims limited to the subgenus wherein **m is 0, n is 1, p is 1, Y<sup>2</sup> is methylene and T is -O-**.


Claims 1, 3-13 and 28-35 are objected to for containing subject matter drawn to nonelected species, but would be allowable if **limited** to the searched and examined subgenus as indicated above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

February 10, 2004